

Atty. Dkt. No. 035451-0120 (3600.Palm)

REMARKS

Applicants respectfully request entry of the foregoing amendments and reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 24, and 47 are currently being amended.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each.

After amending the claims as set forth above, claims 1-69 remain pending in this application.

Claim Rejections - 35 U.S.C. § 103(a)

In section 2 of the Office Action, claims 1-3, 6-9, 11-12, 14-15, 18-20, 24-26, 29-32, 34-35, 37-38, 41-43, 47-49, 52-55, 57-58, 60, 63-65, and 69 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mills et al. (U.S. Patent No. 6,353,870) in view of SDA.

i. Claims 1-3, 6-9, 11-12, 14-15, and 18-20

With regard to claim 1, Applicants respectfully submit that the cited combination of Mills et al. in view of SDA fails to teach, disclose, or suggest all of the elements of claim 1 as combined therein. More specifically, claim 1 has been amended to recite "an expansion slot defined by a first portion of the SDIO module housing, the expansion slot having an SDIO interface configured to selectively couple to one of a Secure Digital (SD) card and a multimedia card (MMC) the first portion of the SDIO module housing configured to be located adjacent and parallel with a back side of the handheld computer so that the expansion slot is entirely external to the housing of the handheld computer." The cited combination of Mills et al. in view of SDA fails to teach, disclose, or suggest "an expansion slot defined by a first portion of the SDIO

Atty. Dkt. No. 035451-0120 (3600.Palm)

module housing, the expansion slot having an SDIO interface configured to selectively couple to one of a Secure Digital (SD) card and a multimedia card (MMC) the first portion of the SDIO module housing configured to be located adjacent and parallel with a back side of the handheld computer so that the expansion slot is entirely external to the housing of the handheld computer" either alone or as included in the combination of elements of claim 1.

In response to Applicants' arguments filed May 23, 2005, the Office Action states that "Fig. 7 shows very clearly this adjacent and parallel connection with the back side of the handheld computer (also addressed in the rejection above)." Mills et al., however, teaches only a removable expansion card 100 having a slot 121 for a removable memory 120 that extends within the housing of a PDA 200. See Figs. 7 and 8. Thus, the cited combination of Mills et al. in view of SDA fails to teach, disclose, or suggest "an expansion slot defined by a first portion of the SDIO module housing, the expansion slot having an SDIO interface configured to selectively couple to one of a Secure Digital (SD) card and a multimedia card (MMC) the first portion of the SDIO module housing configured to be located adjacent and parallel with a back side of the handheld computer so that the expansion slot is entirely external to the housing of the handheld computer" either alone or as included in the combination of elements of claim 1. Accordingly, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §103(a) be withdrawn. Additionally, claims 2-3, 6-9, 11-12, 14-15, and 18-20 depend from claim 1 and are thus patentable over the cited combination of Mills et al. in view of SDA for at least the same reasons as claim 1. Accordingly, Applicants further request that the rejection of claims 2-3, 6-9, 11-12, 14-15, and 18-20 under 35 U.S.C. §103(a) be withdrawn as well.

ii. **Claims 24-26, 29-32, 34-35, 37-38, 41-43**

With regard to claim 24, Applicants respectfully submit that the cited combination of Mills et al. in view of SDA fails to teach, disclose, or suggest all of the elements of claim 24 as combined therein. More specifically, claim 24 has been amended to recite "an expansion slot defined by a first portion of the SDIO module housing coupled to the SDIO module the first portion of the SDIO module housing located adjacent and parallel with a back side of the

Atty. Dkt. No. 035451-0120 (3600.Palm)

housing, the expansion slot having an SDIO interface configured to selectively couple to one of a Secure Digital (SD) card and a multimedia card (MMC), the expansion slot and the slot in the housing both being sized to receive SD cards." The cited combination of Mills et al., in view of SDA fails to teach, disclose, or suggest "an expansion slot defined by a first portion of the SDIO module housing coupled to the SDIO module the first portion of the SDIO module housing located adjacent and parallel with a back side of the housing, the expansion slot having an SDIO interface configured to selectively couple to one of a Secure Digital (SD) card and a multimedia card (MMC), the expansion slot and the slot in the housing both being sized to receive SD cards." either alone or as included in the combination of elements of claim 24.

What is taught by Mills et al. is only that removable expansion card 100 fits in a first sized slot (such as a compact flash slot) of PDA 200, and also has a second sized slot 121 of its own to accommodate an SD sized memory card 120. Mills et al. discloses a smaller slot in the module to accommodate an SD sized card. Thus, Mills et al. in combination with SDA does not disclose, teach or suggest "an expansion slot defined by a first portion of the SDIO module housing coupled to the SDIO module the first portion of the SDIO module housing located adjacent and parallel with a back side of the housing, the expansion slot having an SDIO interface configured to selectively couple to one of a Secure Digital (SD) card and a multimedia card (MMC), the expansion slot and the slot in the housing both being sized to receive SD cards," either alone or as included in the combination of elements of claim 24. Accordingly, Applicants respectfully request that the rejection of claim 24 under 35 U.S.C. §103(a) be withdrawn. Additionally, claims 25-26, 29-32, 34-35, 37-38, 41-43 depend from claim 24 and are thus patentable over the cited combination of Mills et al., in view of SDA for at least the same reasons as claim 24. Accordingly, Applicants further request that the rejection of claims 25-26, 29-32, 34-35, 37-38, 41-43 under 35 U.S.C. §103(a) be withdrawn as well.

MILW_1875147.1

-12-

Application No. 09/821,522

Atty. Dkt. No. 035451-0120 (3600.Palm)

iii. **Claims 47-49, 52,55, 57-58, 60, 63-65, and 69**

With regard to claim 47, Applicants respectfully submit that the cited combination of Mills et al. in view of SDA fails to teach, disclose, or suggest all of the elements of claim 47 as combined therein. More specifically, claim 47 has been amended to recite "an expansion slot coupled to the SDIO module, the expansion slot configured to selectively couple to one of a Secure Digital (SD) card and a multimedia card (MMC), the expansion slot configured to be located entirely external to a housing of the electronic device." The cited combination of Mills et al. in view of SDA fails to teach, disclose, or suggest "an expansion slot coupled to the SDIO module, the expansion slot configured to selectively couple to one of a Secure Digital (SD) card and a multimedia card (MMC), the expansion slot configured to be located entirely external to a housing of the electronic device" either alone or as included in the combination of elements of claim 47. For example, Mills et al. teaches only a removable expansion card 100 having a slot 121 for a removable memory 120 that extends within the housing of a PDA 200. See Figs. 7 and 8. Accordingly, Applicants respectfully request that the rejection of claim 47 under 35 U.S.C. §103(a) be withdrawn. Additionally, claims 48-49, 52,55, 57-58, 60, 63-65, and 69 depend from claim 47 and are thus patentable over the cited combination of Mills et al. in view of SDA for at least the same reasons as claim 47. Accordingly, Applicants further request that the rejection of claims 48-49, 52,55, 57-58, 60, 63-65, and 69 under 35 U.S.C. §103(a) be withdrawn as well.

In Sections 3-9 of the Office Action the Examiner rejected various dependent claims under 35 U.S.C. §103 with the primary references being the combination of Mills et al. and SDA. Applicants respectfully submit that the dependent claims rejected in these sections of the Office Action are allowable for the same reasons as provided above with regard to their respective independent claims 1, 24, and 47.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

Atty. Dkt. No. 035451-0120 (3600.Palm)

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 11/8/2005

By Chad E. Bement

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5554
Facsimile: (414) 297-4900

Chad E. Bement
Attorney for Applicant
Registration No. 54,991